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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,766	12/08/2003	Deb K. Chatterjee	0942.4200002/RWE/JKM	9843

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,766	Applicant(s) CHATTERJEE ET AL.	
	Examiner Maryam Monshipouri	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 96-110 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 96-110 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Claims 1-95, 111-116 have been canceled. Claims 96-110 are still at issue and are present for examination.

Applicants' arguments filed on 7/31/06 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 96-110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "thioredoxin polypeptide" in claim 96 and its dependent claims 97-110 is indefinite. Applicant has not defined said term in the specification. It is unclear what is the difference between "thioredoxin" and thioredoxin polypeptide" as "thioredoxin" by inherency is a polypeptide.

Claim 110 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether SEQ ID NO:8 is the nucleotide sequence of E. coli thioredoxin or the nucleotide sequence of truncated "thioredoxin polypeptide".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 96-100, 109-110 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of making stained molecular weight markers comprising producing a "thioredoxin polypeptide" comprising thioredoxin or a truncated thioredoxin, does not reasonably provide enablement for a method of making stained molecular weight markers comprising producing a "thioredoxin polypeptide" comprising a "modified" thioredoxin.

The criteria for undue experimentation, summarized in *re Wands*, 8, USPQ2n 1400 (Fed. Cir. 1988) are: 1) the quantity of experimentation necessary, 2) the amount of direction or guidance presented, 3) the presence and absence of working examples, 4) the nature of the invention, 5) the state of prior art, 6) the relative skill of those in the art, 7) the predictability or unpredictability of the art, and 8) the breadth of the claims.

The term "modified thioredoxin" in claim 96 (and its dependent claims 97-100, 109-110) may be interpreted as a thioredoxin in which numerous amino acids are substituted, deleted, truncated, inserted, chemically modified etc. The specification fails to teach how "thioredoxin polypeptides" comprising for example, elongated thioredoxin (i.e. modified thioredoxin by insertion) can retain the ability to form inclusion bodies upon expression in a bacterial host. No examples of such "modified" thioredoxins beyond truncated forms are provided either. Current state of prior art indicates that once many additional amino acids at the amino or carboxyl terminal of thioredoxin have been substituted or added(inserted) etc. said "modified" thioredoxin is not necessarily going to have the ability to form inclusion bodies upon expression in bacterial host cells.

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Therefore, due to lack of sufficient guidance and examples provided in the specification and due to unpredictability of prior art as to which "modified thioredoxins" are capable of forming inclusion bodies upon expression in bacterial host cells, one of skill in the art has to go through the burden of undue experimentation in order to screen for those "modified thioredoxins" that result in inclusion bodies upon expression in bacterial host cells and as such the claims go beyond the scope of the disclosure.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weber Jon P. can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Monshipouri

Maryam Monshipouri Ph.D.

Primary Examiner
